

REMARKS

Applicants have carefully considered the Office Action dated August 13, 2003 and the references cited therein. In view of the foregoing remarks, reconsideration is respectfully requested.

In this Amendment Claim 11 has been amended, and new Claims 24 and 25 have been added. Accordingly, Claims 1-25 are presented for consideration.

In the Office Action, the Examiner has indicated that Claims 17-20, 22 and 23 are allowed. In addition, Claims 2 and 8 have been rejected as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claim. Applicants gratefully acknowledge this indication of allowable subject matter.

In the Office Action, the Examiner has rejected Claims 1, 3-7, 9-10, 13-16 and 21 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,044,582 to Walters (“Walters”) in view of U.S. Patent No. 5,803,653 to Zufetti (“Zufetti”) and further in view of U.S. Patent No. 4,909,405 to Kerr, Jr. (“Kerr, Jr.”).

The Examiner contends that neither Walters nor Kerr, Jr. discloses a second channel that extends into the first channel interior when the first and second channels are engaged. For this feature, the Examiner cites Zufetti which shows channel-shaped members (2) wherein the first channel member extends into a second channel member and the second channel member extends into the first channel member when the first and second channels are engaged. The Examiner contends it would have been obvious to one skilled in the art at the time of the invention from the teachings of Zufetti to have modified the channel members of Walter and Kerr, Jr. by modifying their shape to have a configuration shown above in order to prevent rotation between channel members.

Applicants respectfully traverse the rejection of Claim 1 based upon the combination of the cited references.

Claim 1 defines a hanger bar assembly including a first channel member and a second channel member. The first and second channel members each have a channel interior and a

portion of the first channel extends into the second channel of its interior and a portion of the second channel extends into the first channel interior when the first and second channels are engaged. The Examiner has cited Zufetti contending that it discloses a first and second channel having a portion of the first channel extending into the interior of the second channel and a portion of the second channel extending into the interior of the first channel. The Examiner further contends that this teaching may be applied to Walters and Kerr, Jr. in order to render the claim obvious. Applicants respectfully submit that the combination proposed by the Examiner is not obvious and that one skilled in the art would not be motivated to make such a combination without employing the hindsight obtained by the present invention.

In order to properly combine or modify prior art references, there must be a teaching to do so in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). The mere fact that references can be combined or modified does not render the combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

Neither Walters nor Kerr, Jr. lends itself to being modified as suggested by the Examiner and such a combination would be undesirable. The Walters' reference discloses a pair of tubes 11, 12 with the tube 12 extending completely within the interior of the outer tube 11. Tube 11 has a square cross-sectional profile which is inserted within an upper portion of tube 12 which has a corresponding cross-sectional profile shown in Figure 3. In this design, rotation and lateral movement is prevented by the interconnection of the square-shaped profile of tube 11 and the corresponding four-cornered profile of outer tube 12. Depending downwardly from the square portion of outer tube 11 is a somewhat u-shaped portion having a bottom wall 73, as shown in Figure 3. The bottom wall of outer tube 11 and inner tube 12 include a plurality of spaced holes 71 and 72, which permit a tool 76 to be inserted therein. This tool when pivoted can be used to move the inner tube relative to the outer tube.

Zufetti discloses a pair of structural bars 1 and 6 formed of sheet metal for mounting temporary walls. The bars are channel shaped members having a slot extending along the

entire length of the bar. The outer bar 1 includes inwardly turned u-shaped edges which engage wings 7 extending from inner tube 6. These edges and wings are formed by edges which bound a longitudinally extending slot in one of the channel walls. (See Figure 1). The specification teaches that this feature is for reducing “transversal slack” between the members and not for reducing rotation. (See Column 3, lines 16-18).

One skilled in the art would not be motivated to combine the interconnecting edges and slots of Zufetti with the square-shaped profiles of Walters. Modifying Walters' inner tube 12 to include the channel profile of Zufetti having a longitudinal slot extending over its length would provide no benefit and would even render the support assembly less effective. In Walters the interconnection between the inner and outer square-shaped tubes prevents rotation between the tubes. Each outside corner of the inner tube 12 interacts with a corresponding inside corner of outer tube 11. This interaction resists rotational and translational movement between the members. There would be no need, or desirability to undergo the extensive modification of the tubes to form slots and the edges as in Zufetti. Slotting the tubes of Walters would also make them more susceptible to rotational forces than square tubes, as the tubes themselves could twist. Walters offers a solution for preventing rotation between the members, and there would be no motivation to replace that solution to the one offered in Zufetti. There is no desirability to perform such a modification when no advantage is obtained or when the modification would be disadvantageous. Accordingly, there would be no motivation to modify Walters in order to include the features of Zufetti.

With regard to the hanger assembly of Kerr, Jr., this device includes a pair of round tubular members 12 and 14 with one telescopically slideable within the other. As in Walters, only the inside tube is received within the outside tube, and no portion of the outside tube extends into the inside tube. As set forth in Applicants' amendment filed on June 12, 2003, the Kerr, Jr. reference requires that one tube rotate with respect to each other in order to install the device. Accordingly, there would be no teaching to modify the structure of Kerr, Jr. to include interlocking channel members as set forth in Zufetti. Such modification would render the Kerr, Jr. device unusable for its intended purpose since rotation of one tube

relative to the other is necessary in order to install the hanger assembly. Accordingly, there would be no basis for modifying Kerr, Jr. to include the limitations of Zufetti.

Applicants respectfully submit that there is no motivation in the prior art to modify either Kerr, Jr. or Walters to include the structure of Zufetti as contended by the Examiner. Therefore, Claim 1, and those claims depending therefrom, patentably distinguish over the references of record.

With regard to independent Claims 15 and 21, the Examiner contends that Zufetti discloses a first channel member having a plurality of longitudinally extending first grooves (between 4 and 5) and a plurality of longitudinally extending first rails (5), the second channel member having a plurality of longitudinally extending second rails (7) and a plurality of longitudinally extending second grooves (between 7 and the other side of the channel member).

The cooperating rail and groove feature defined in Claims 15 and 21 are not found in Walters. However, the Examiner asserts that one skilled in the art would be motivated to modify Walters in order to include the u-shaped edges 5 and wings 7 of Zufetti. As stated above with regard to Claim 1, such a modification would require an extensive reworking of Walters and would not provide any improvement to the design. There is no specific teaching in the references to replace or modify the manner disclosed in Walters in which the inner and outer tubes prevent rotation or other unwanted movement. Furthermore, slotting the tubes of Walters to form the wings and grooves of Zufetti would not add any benefit and reduces the tubes' ability to resist rotation. Accordingly, one skilled in the art would not be lead to make such a modification. Therefore, Claims 15 and 21, and those claims depending therefrom, patentably distinguish over the references of record.

With regard to Claim 10, the Examiner contends that Walters discloses a basic inventive concept including a hanger bar for supporting an outlet box spaced between support elements having a first channel and a second channel of similar cross-sectional profiles. The Examiner contends that various other features of the invention are taught by Walters. However, the Examiner concedes that Walters does not disclose first and second channel

members having apertures formed therein to receive fastening hardware to secure the end plates to the support bar. For this feature, the Examiner cites Kerr, Jr.

The Examiner asserts that Kerr, Jr. discloses a support bar having first and second channel members 12, 14 including apertures formed therein to received fastening hardware 52 to secure the end plates 28 to the support bar. Therefore, it would have been obvious to one skilled in the art to have modified the support bar of Walters to have an aperture in the end in order to have a more secure attachment plate in the support bar. Applicants respectfully traverse the obviousness rejection of Claim 10 in view of Walters and Kerr, Jr.

Contrary to the Examiner's contention, fastening hardware 52 does not secure the end plates to the support bar. As set forth in column 4, lines 35-50 of Kerr, Jr., the end plate 28 is held on in a rotatable manner by an o-ring gasket 36. Specifically, the specification states "[t]he nose end of the plug includes a shoulder 26 supporting a leg stand 28 and a flange-like collar 30 rotatably floating thereon. A plurality of circumferentially spaced axially extending prongs or teeth 32 are provided on collar 30. An annular groove 34 at the distal end of the nose receives an o-ring gasket 36 whereby the stand 28 and collar 30 are retained in their free-floating relation about shoulder 26." (Column 4, lines 42-49). On the opposite end of the support bar a closure cap 18 includes a hollow sleeve in which there is provided internally a plurality of axially extending sharpeners 46 and a wedge shaped key 48. The specification indicates that the "key is adapted to wedge into a force fit with slot 50 of tube 14 with the ribs effecting a biting relation with the tube periphery thereat." (Column 4, lines 58-63). The wood screw 52 extends through the cap 18 and is held there by the use of Loctite™. The specification does not specifically indicate how this end plate is held on to this end of the support bar, but it must be able to rotate with respect to the tube and fastener 52, otherwise installation would not be possible. The feet of the end plate 28 are located on the ceiling surface and the tube 14 is rotated to cause screw 52 to engage joist 66. (Column 6, lines 45-50). The fastener 52 does not secure the end plate to the tube as required by the claims at issue. The fastener is simply to secure the assembly to the joist 66. Even the closure cap 18 is not held on by a fastener but is held on by the use of a wedge shaped key 48 and sharp ribs 46. These bite into the exterior of the tube in order to secure it thereto. The Kerr, Jr.

reference does not disclose a first and second channel member each having a plurality of apertures integrally formed therein to receive fasteners, nor does this disclose a pair of end plates attached to opposite ends of the support bar by a plurality of fasteners extending into said plurality of apertures.

Accordingly, Applicants respectfully submit that the proposed combination does not teach all the limitations of the claimed invention. Therefore, Claim 10 and those claims depending therefrom patentably distinguish over the references of record.

Applicants further note that Claim 21 also defines the first and second channel members including apertures formed therein for receiving fastening hardware to secure end plates to said support bar. Accordingly, for the reasons set forth above with respect to Claim 10, Applicants submit that Claim 21 also defines over the references of record.

Claims 11 and 12 which depend from Claim 10, have been rejected under 103(a) in view of Walters, Zufetti, Kerr, Jr., and U.S. Pat. No. D395,816 to Colodny (“Colodny”). Colodny discloses a cable support bracket having a channel formed by a longitudinally extending connecting wall and a pair of longitudinally extending spaced sidewalls extending perpendicularly from the connecting wall. The connecting wall includes a plurality of slots. The sidewalls do not include any openings.

Claim 11 defines the first channel member as including a first and second spaced side wall extending from a connecting wall to define a channel. The first side wall includes one of said plurality of apertures formed therein. Applicants note that Claim 11 has been amended to correct a typographical informality, which does not affect the claim’s scope.

Applicants respectfully submit that the combination of references does not teach the limitations of Claim 11. In Colodny, the wall which connects the spaced side walls, *i.e.*, the connecting wall, includes a plurality of apertures formed therein. The spaced sidewalls do not include apertures. Accordingly, each limitation of Claim 11 is not found in the cited references. Therefore Claim 11 and those claims depending therefrom patentably distinguish over the cited references.

Applicants have added new Claims 24 and 25 which depend from Claims 1 and 10, respectively. These claims define the first and second channel members as having the same cross-sectional profiles. In light of the Examiner's reasons for allowance, Applicants respectfully submit that Claims 24 and 25 define over the references of record.

In light of the comments set forth above, Applicants respectfully request favorable reconsideration of the rejected claims; consideration of amended Claim 11 and new Claims 24-25; and allowance of the application with Claims 1-25. If the Examiner believes that a telephone interview would be helpful in moving the case toward allowance, she is respectfully invited to contact Applicants' attorney at the telephone number set forth below.

Respectfully submitted,


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